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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/921,327	08/02/2001	Gerald W. Back	31844.0700	5061

7590

10/28/2003

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EXAMINER

THOMAS, DAVID B

ART UNIT PAPER NUMBER

3723

DATE MAILED: 10/28/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/921,327

Applicant(s)

BACK ET AL.

Examiner

David B. Thomas

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 13-16 and 20 is/are rejected.
- 7) ☒ Claim(s) 5-12, 17-19 and 21-25 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1-4, and 13-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Mizuta (6,170,116).

Mizuta ('116) discloses an abrasive member and cleaning device for a probe tip comprising: a support structure 4 having a surface; and a pad formed on the surface of the support structure, wherein the pad comprises an adhesive 3 and a plurality of abrasive particles 14 in contact with the adhesive; wherein said adhesive 3 is located in an adhesive layer 3; wherein said plurality of abrasive particles is located in an abrasive layer; wherein said adhesive is located in an adhesive layer and wherein said plurality of abrasive particles is located in an abrasive layer; wherein the size of the abrasive

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particles is between 0.01 microns and 90 microns; wherein the support structure is a semiconductor wafer (Col. 10, lines 17-20), wherein the adhesive is an acrylic adhesive, and wherein the abrasive particles are diamond particles. Mizuta ('116) also discloses a method for cleaning and shaping a probe tip comprising the steps of: inserting the probe tip into a multi-layered adhesive and abrasive particle pad; and extracting the probe tip (Col. 10, lines 42-55); wherein the step of inserting the probe tip comprises inserting the probe tip a predetermined distance into the pad, wherein said predetermined distance is a function of tip length and pad thickness (Col. 10, lines 15-34).

3. Claim 20 is rejected under 35 U.S.C. 102(e) as being anticipated by Maeda et al. (6,306,187).

Maeda et al. ('187) discloses an abrasive material for the needle point of a probe card which can effectively remove foreign matter adhering to the needle point of the probe, protect the needle point from damage and deformation, and prolong the life of the probe. The abrasive material for the needle point of a probe card comprises an abrasive layer including a layer of micropowdered abrasive grains applied to a substrate and a cushion layer having a buffer action and elasticity. The pad is made by applying an adhesive layer to a support structure, and applying a plurality of abrasive particles to said adhesive layer to form an abrasive particle layer (Col. 4, lines 8-22).

***Allowable Subject Matter***

4. Claims 5-12, 17-19, and 21-25 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all

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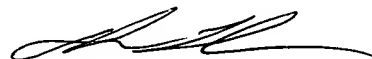
of the limitations of the base claim and any intervening claims.

***Conclusion***

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David B. Thomas whose telephone number is (703) 308-4250. The examiner can normally be reached on 8:00-6:30 M-TH.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph J. Hail can be reached on (703) 308-2687. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.



David B. Thomas  
Patent Examiner  
Art Unit 3723

  
dbt